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35437 7590 10/09/2007 MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO 666 THIRD AVENUE NEW YORK, NY 10017			EXAMINER WON, MICHAEL YOUNG	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/668,875  
Filing Date: September 25, 2000  
Appellant(s): FREESTONE ET AL.

\_\_\_\_\_  
Richard M. Lehrer (Reg. No. 38,536)  
Boris A. Matvenko (Reg. No. 48,165)  
For Appellant

**EXAMINER'S ANSWER**

1. This is in response to the appeal brief filed July 5, 2007 appealing from the Office action mailed October 17, 2006.

**Real Party in Interest**

2. The appellants' statement identifying the real party in interest contained in the brief is correct.

**Related Appeals and Interferences**

3. The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**Status of Claims**

4. The appellants' statement of the status of claims contained in the brief is correct.

**Status of Amendments**

5. The appellants' statement of the status of amendments after contained in the brief is correct.

**Summary of Claimed Subject Matter**

6. The appellants' summary of claimed subject matter contained in the brief is correct.

**Grounds of Rejection to be Reviewed on Appeal**

7. The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**Claims Appendix**

8. The appellants' copy of the appealed claims contained in the Appendix to the brief is correct.

**Evidence Relied Upon**

5,732,216	Logan et al.	3-1998
6,085,231	Agraharam et al.	6-2000

**Grounds of Rejection**

9. The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-10, 12-19, 21-31, 33-41, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Logan et al. (US 5,732,216 A).

**INDEPENDENT:**

As per **claim 1**, Logan teaches an electronic message configured to be communicated between a sender's device and a recipient's device, the electronic message comprising:

a sound file attached to the electronic message (see col.42, line 67 to col.43, line 2: "the comment could be transmitted as audio file attachment to an E-mail message"); and,

a predetermined identifier, associated with the sound file, that both distinguishes said sound file from other files attached to the message (see col.5, line 66 to col.6, line 5: "program files making up an individual session are stored in a session schedule file... which contains program identifiers of the program segments to be played") and indicates a course of action to be taken by the recipient's device with said sound file (see col.11, lines 4-11: "formed into a schedule file... consisting of a sequence of program segment identification numbers... which contains more detailed information about the sequence of events which occur during playback").

As per **claim 8**, Logan teaches a method for sending an electronic message from a sender's device and a recipient's device comprising:

attaching a sound file to an electronic message (see col.42, line 67 to col.43, line 2: "the comment could be transmitted as audio file attachment to an E-mail message"); and,

associating a predetermined identifier with said sound file, which both distinguishes said sound file from other files attached to the e-mail (see col.5, line 66 to col.6, line 5: "program files making up an individual session are stored in a session schedule file... which contains program identifiers of the program segments to be played") and which indicates a course of action to be taken by the recipient's device with said sound file (see col.11, lines 4-11: "formed into a schedule file... consisting of a sequence of program segment identification numbers... which contains more detailed information about the sequence of events which occur during playback").

As per **claim 24**, Logan teaches a method for announcing electronic messages comprising:

receiving an electronic message with an attached sound file (see col.42, line 67 to col.43, line 2: "the comment could be transmitted as audio file attachment to an E-mail message");

noting the presence of a predetermined identifier that distinguishes said sound file from other files attached to the message (see col.5, line 66 to col.6, line 5: "program files making up an individual session are stored in a session schedule file... which contains program identifiers of the program segments to be played"); and,

playing the attached sound file (see col.7, lines 62-66: "played... in the sequence established") in response to the noting of the predetermined identifier (see col.7, lines 36-41: "identifies the order in which downloaded program segments are to be played").

**DEPENDENT:**

As per **claims 2-4, 14-16, and 26-28**, Logan further teaches wherein said sound file contains at least one word in a computer-simulated voice and at least one word in a sender's voice (see col.28, lines 19-26).

As per **claim 5**, Logan further teaches wherein the predetermined identifier is a specific file name associated with said sound file (see col.5, lines 6-15).

As per **claims 6, 17, and 29**, Logan further teaches wherein the predetermined identifier is an information tag (see col.44, lines 12-15).

As per **claims 7, 18, and 30**, Logan further teaches wherein the information tag is embedded in a header of the electronic message (see col.43, lines 5-15).

As per **claim 9**, Logan further teaches wherein said attaching is performed by the sender's device (see col.15, lines 15-19).

As per **claim 10**, Logan further teaches wherein said attaching is automatic (see col.10, lines 28-36).

As per **claim 12**, Logan further teaches wherein said attaching, is performed by an e-mail server (see col.4, lines 40-46 and col.6, lines 39-41).

As per **claim 13**, Logan further teaches wherein said attaching is, performed by the recipient's device (see col.2, lines 10-14 and col.15, lines 15-19).

As per **claims 19 and 31**, Logan further teaches wherein the information tag, is embedded by the sender's device or by a sender computer (see col.43, lines 26-33 & 46-60 and col.44, lines 12-15).

As per **claims 21 and 33**, Logan further teaches wherein the information tag, is embedded by an e-mail server (see claim 7 and 19 rejection above).

As per **claim 22 and 34**, Logan further teaches wherein the information tag, is embedded by the recipient's device or by a recipient computer (see claim 13 and 19 rejection above).

As per **claim 23**, Logan further teaches wherein said attaching, is selectively performed by a sending party (see col.11, lines 27-34).

As per **claim 25**, Logan teaches of further comprising receiving at least one more electronic message with an attached sound file and playing said at least one more sound file (see col.7, lines 51-61).

As per **claim 35**, Logan further teaches wherein said playing is selective (see col.46, lines 26-28).

As per **claim 36**, Logan further teaches wherein said playing is performed at a recipient computer (see col.1, lines 42-49).

As per **claim 37**, Logan further teaches wherein said playing is performed at recipient customer premise equipment (see col.1, lines 42-49)

As per **claim 38**, Logan further teaches where said playing is performed at a recipient voice mail (see col.15, lines 31-46).



As per **claim 39**, Logan teaches of further comprising converting the content of the electronic message to a voice message (see col.28, lines 19-26).

As per **claim 40**, Logan further teaches where said converting is performed at an e-mail server (see col.5, lines 26-31).

As per **claim 41**, Logan further teaches where said converting is performed at a recipient computer (see col.5, lines 16-26).

As per **claim 44**, Logan further teaches wherein said converting is performed using a sound file as a voice sample.

As per **claim 45**, Logan teaches of further comprising transferring said voice message to a voice mailbox (see col.15, lines 31-46 and col.29, lines 36-41).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11, 20, 32, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan et al. (US 5,732,216 A) in view of Agraharam et al. (US 6,085,231 A).

As per **claims 11, 20, 32, and 42**, Logan further teaches wherein said attaching is performed by the sender's device (see claim 9 rejection above), wherein the information tag is embedded by the sender's device or by a computer at a sending

party's end (see claim 7 rejection above), and wherein said converting is performed at a computer at the receiving party's end.

Logan does not explicitly teach of an adjunct to a sender or a receiver for performing these steps.

Agraharam teaches of an adjunct (see col.3, lines 20-29: "email server which is part of or an adjunct to the called party/subscriber's").

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Logan in view of Agraharam by implementing an adjunct. One would be motivated to do so because Logan suggests other numerous embodiments (see col.45, lines 19-25) and such embodiment of separating functionality into different adjunct devices, significantly reduces load on one processor and improves processing time.

As per **claim 43**, Logan does not explicitly teach wherein said converting is performed at a voice messaging system.

Agraharam teaches wherein said converting is performed at a voice messaging system (see Fig.2, #202 & #206 and col.4, lines 7-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Logan in view of Agraharam so that the converting is performed at a voice messaging system. One would be motivated to do so because Logan teaches that compressed audio or text can be "converted into audio form by a conventional speech synthesis program" (see col.3, lines 37-41).

### **Response to Argument**

12. The examiner summarizes the various points raised by the appellant and addresses replies individually.

13. As per appellants' arguments filed July 5, 2007, the appellant(s) argue in substance:

(a) That the limitations of independent claims 1, 8, and 24 are not anticipated under 35 U.S.C. 102(b) by Logan.

Specifically the appellants' argues that the cited references are "multiple, different and unrelated exchange of information that occur within the Logan system" and that Logan does not teach that the program\_id is transmitted with the e-mail".

**In response to (a):** Although the previous office action cited multiple different locations regarding different exchange of information. It is clear that the information is the same. Regardless of whether the information is program segment, voice message, comment or annotations, uploaded, downloaded or transmitted via an email system, the information (**audio file**) remains the same (see col.15, lines 31-46).

For clarity, the examiner has reduced the reference citation to one for each element of the claimed invention in the rejection above, although there are numerous locations throughout the Logan patent teaching the broad claim limitations. Logan clearly teaches that E-mail messages can comprise an audio file attachment (see col.42, line 67 to col.43, line 2: "the comment could be transmitted as audio file attachment to an E-mail message"). The attachment of files to emails is neither novel

nor inventive and general knowledge known to one of ordinary skill in the art.

Additionally, Logan teaches that each files contains *program identifiers* or *program segment identification numbers* that indicate the course of action or *sequence of events* to be played back (see col.5, line 66 to col.6, line 5: "program files making up an individual session are stored in a session schedule file... which contains program identifiers of the program segments to be played" and col.11, lines 4-11: "formed into a schedule file... consisting of a sequence of program segment identification numbers... which contains more detailed information about the sequence of events which occur during playback").

Although it is inherent according to Logan's teachings above, that if sound file were attached to an email the associate identifier would also be attached, such limitation is not recited in the claims 1 and 8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "program\_id is transmitted with the e-mail") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 1 and 8 merely recite the functionality of attaching a sound file to an electronic message and the existence of an identifier associated with the sound file that identifies the sound file and indicates what to do with the sound file. There is no recitation explicitly claiming that the identifier is attached to the electronic message. According to the citations above, these limitations are taught.

For the reasons and the rejection set forth above, Logan clearly teaches all the limitations of claims 1, 8, and 24.

**(b)** That the limitations of dependent claims 11, 20, 32, 42, and 43 are not rendered obvious under 35 U.S.C. 103(a) by Logan in view of Agraharam.

Specifically, the appellants' argues that since Logan does not teach all the limitations of independent claims 1, 8, and 24, Logan also fails to teach all the elements of dependent claims 11, 20, 32, 42, and 43

Furthermore, the appellants' argues that no motivation to combine exists within the references.

**In response to (b):** For the reasons to (a) and further in response to the rejection set forth above, Logan clearly and explicitly teach all the limitations of claims 1, 8, and 24. Logan and Agraharam further teach all the limitations of claims 11, 20, 32, 42, and 43.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the **knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Logan suggests other numerous embodiments (see col.45, lines 19-25) and such embodiment

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of separating functionality into different adjunct devices, significantly reduces load on one processor and improves processing time. Furthermore, adjunct devices in networks such as the Internet is knowledge generally available to one or ordinary skill in the art networks.

**Related Proceeding(s) Appendix**

14. There are no copies of any decisions rendered by a court or the Board in any proceedings.

15. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael Won/  
Primary Examiner  
September 20, 2007

Conferees:

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